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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,379	11/15/2001	John Joseph Mascavage III	020375-002710US	2669
20350	7590	11/04/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			CHENCINSKI, SIEGFRIED E	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)
	09/991,379	MASCAVAGE ET AL.
	Examiner	Art Unit
	Siegfried E. Chencinski	3628

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) The period for reply expires ____ months from the mailing date of the final rejection.
- b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. The proposed amendment(s) will not be entered because:
 - (a) they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) they raise the issue of new matter (see Note below);
 - (c) they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: ____.

3. Applicant's reply has overcome the following rejection(s): ____.
4. Newly proposed or amended claim(s) ____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: ____.

Claim(s) objected to: ____.

Claim(s) rejected: 1-20.

Claim(s) withdrawn from consideration: ____.

8. The drawing correction filed on ____ is a) approved or b) disapproved by the Examiner.

9. Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). ____.

10. Other: ____.

HYUNG SOO GH
 SUPERVISORY PATENT EXAMINER
 TECHNOLOGY CENTER 3600

Continuation of 5. does NOT place the application in condition for allowance because: 1. Re. the argument in p. 7, l. 3 - p. 9, l. 19, that Applicant's specification, particularly the section of p. 19, l. 23 - p. 20, l. 23, supports the claim element "automatically opening a new web browser window for the customer". This section does mention a pop-up window but, as noted in the final rejection, it fails to support the specific method of the claim element. It may be true that one could program a feature for the "automatic opening a new web browser window for the customer", but the specification is silent on this feature. After all, there are many other unstated programming possibilities.

2. Re. the arguments presented in p. 9, l. 20 - p. 10, l. 21 against the 35 USC 103 rejection:

- a) Fung and its parent, application # 60/186,303, both explicitly disclose the prior art for which Fung is cited in the rejection, and the parent's filing date is March 1, 2000, which is prior to the date of Applicant's invention.
- b) Applicant argues that a proper *prima facie* case of obviousness has not been set forth. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner is relying on the knowledge generally available to one of ordinary skill in the art and the motivations to combine cited in each rejection, i.e. to establish an automated purchasing method which includes efficient automated web based steps for validating the payment for an online transaction without exposing the customer's personal information, and to establish an automated purchasing method which included a time limit for notifying a vendor of payment approval for an automated transaction in order to protect a vendor from undue delay in verifying such a transaction.
- c) Re. the argument that Fung uses a pop-up window in a different way, the examiner wishes to point out that Fung's teaching is in the same context as that of Applicant's invention, namely online transactions with consumer customers. It matters not during which step the teaching occurs, since the one of ordinary skill in the art would recognize the potential of this specific teaching and apply it wherever it is convenient in his particular invention.
- d) Re. the argument that there is a lack of motivation to combine, for example, in the rejection of claims 1, 10 & 17. One motivation to combine on the part of an ordinary practitioner of the art at the time of applicant's invention was to provide conveniences of automated steps to the customer during an online buying or authorization process while protecting the customer's personal information (Fung, [0006, ll. 5-12]).
- e) Re. the argument that the rejections are based on impermissible hindsight, a court has ruled as follows: Applicants may argue that the examiner's conclusion of obviousness is based on improper hindsight reasoning. However, "[a]ny judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). In the instant Office Action motivations such as those cited in the Office Action make it clear that a practitioner of ordinary skill in the art would have combined the cited prior art, the cited motivations being to establish an automated purchasing method which includes efficient automated web based steps for validating the payment for an online transaction without exposing the customer's personal information, and to establish an automated purchasing method which included a time limit for notifying a vendor of payment approval for an automated transaction in order to protect a vendor from undue delay in verifying such a transaction.